

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**D. Remarks**

Rejection of Claims 1 and 10 Under 35 U.S.C. §103(a), based on *Ross, Jr. et al.* (U.S. Patent No. 6,629,125) in view of *McGee* (U.S. Patent No. 6,351,738), further in view *McGee* (U.S. Patent No. 6,393,468).

Applicant has assumed that the Office Action includes a typographical error, and that claims 1-5 and 10-14 are being rejected based on the above combination of references.

D) Claims 1-5 are patentable over the cited references

The rejection of claim 1-5 will first be addressed.

The invention of claim 1 is directed to a franchise system for organizing and establishing a headquarter for business transactions over a network. The franchise system includes various components including at least one headquarter network server, a plurality of franchise store servers, and a plurality of member servers.

The headquarter network server has a number of elements including merchandise information memory data, a home page creation system, a home page sending service, and order receiving system, a received data transfer system, and a franchise store ID system.

The home page creation system creates a home page of each franchise store. Similarly, the home page sending service sends home page data for the home page of each franchise store to at least one predetermined member server, including information from the merchandise information memory data.

The franchise store ID system matches a franchise store to a person ordering via a member terminal. Such matching between persons and franchise stores is based on uniform resource locators (urls) set up in advance according to predetermined rules.

As is well established, to establish a prima facie case of obviousness, a rejection must meet three basic criteria. First, there must be some suggestion or motivation to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all claim limitations.

Applicant traverses the present rejection based on a number of grounds.

A) The Combination of References Does Not Show All Claim Limitations

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The cited combination of references does not show or suggest all the limitations of claim 1. In particular, the references do not show or suggest: (1) a plurality of franchise store servers, (2) a home page creation system, or (3) a franchise store ID system.

5
1) **No “plurality of franchise store servers”**

Applicant’s claim 1 recites “a plurality of franchise store servers” where each such franchise store server “corresponds to a different franchise store”. The rejection relies on the reference *Ross, Jr. et al.* to show such a limitation.¹ Applicant does not believe the reference
10 shows such a limitation.

Ross, Jr. et al. shows a commerce system with a processor, the duties of which are split among three tiers, including a web server tier, an application server tier, and a database server tier. Each tier can include several computer systems:

15 [T]he duties of the processor are split among several computer systems 120a-120c, 125a-125d, 130a-130b. The data store may be implemented through a database system 130a-130b, 135a-135d. (*Ross, Jr. et al.*, Col. 4, Lines 62-65).

In the description of such server tiers, servers are never described as “corresponding to a different franchise store”, as recited in claim 1. In fact, the reference would seem to teach away from such
20 an arrangement by spreading the same functionality over multiple servers. That is, the system of *Ross, Jr. et al.* provides one server that accommodates multiple hosts, i.e., multiple functions:

This arrangement also provides fault tolerance since the failure of one server will
25 not incapacitate the system as long as another server providing the same service is alive. (*Ross, Jr. et al.*, Col. 5, Lines 5-8).

Thus, the cited reference is not believed to show or suggest multiple store servers, where each such server corresponds to a different store. For this reason alone, this ground for rejection is
30 traversed.

¹ See the Office Action, dated November 1, 2004, Page 2, Last Partial Paragraph.

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2) No "home creation system"

Applicant's claim 1 also recites a home page creation system that creates a home page for each franchise store.

5 Applicant believes the reference teaches away from the above limitations.

Importantly, the system of *Ross, Jr. et al.* does not create or provide any host home pages, whatsoever. *Ross, Jr. et al.* shows a system that includes a web server tier that provides links for a host's website. Such links are designed to match the "look and feel" of host's website, but are only links, not an entire homepage, as recited in claim 1. It appears that any home pages are
10 maintained separately by the hosts themselves, and are never created nor provided by the server tiers of *Ross, Jr. et al.* This fact is supported by numerous parts of the reference, only a few of which are cited below:

A typical embodiment of the present invention will include a data store... and a
15 processor. The processor performs the tasks of capturing a look and feel description associated with a host website... *providing the host website with a link that link correlates the host website with a commerce object for inclusion within a page on the host website...*(*Ross, Jr. et al.*, Col. 4, Lines 46-54, emphasis added).

20

Thus, the above citation clearly indicates that the system cited by the reference only provides links that are included in the host's website not any web page of host website. This appears to be the exact opposite of Applicant's approach, which is to provide multiple franchisor home pages with at least one headquarter server.

25

Another expert from *Ross, Jr. et al.* repeats this important distinction between the Applicant's invention, and the system shown in the reference:

When a customer clicks on a *host buying opportunity (link)*, the next page loaded will be a shopping page... (*Ross, Jr. et al.*, Col. 12, Lines 54-55, emphasis added).

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The above citation indicates that one first clicks on the host's website. It is only after this that

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the system of *Ross, Jr. et al.* will provide link information. Thus, the home page for the host is not provided by the system of *Ross, Jr. et al.*

The below excerpt shows the same arrangement.

5 The shopping module is the part of the application that allows customers to find, search, select and buy a product... FIG. 22 depicts pages and procedures in a shopping process as implemented in a preferred embodiment... *The customer was on a host site and saw a link* to buy something created via the Link generator 2200. When he or she clicks on the link, *he or she is taken to* the shopping page
10 parameterized with the Link ID 2210... (*Ross, Jr. et al.*, Col. 16, Lines 6-17, emphasis added).

Again, the above shows that any initial page accessed by a customer is on the host's site, which is some other site provided by a different entity. The system of *Ross, Jr. et al.* provides links, not
15 web pages.

A Host is the operator of a website that engages in Internet commerce *by incorporating one or more link to the e-commerce outsource provider into its web content...* (*Ross, Jr. et al.*, Col. 16, Lines 6-17).

20

The above clearly shows how a host has a website separate from an "e-commerce outsource provider", and incorporate links to the e-commerce outsource provider. The e-commerce outsource provider is the system of *Ross, Jr. et al.*²

25 The above is believed to firmly establish that the system of the cited reference *Ross, Jr. et al.* cannot show Applicant's claim limitations, as it only provides links to Host pages (such as home pages) residing at some other location, and hence cannot and is not intended to, provide home pages themselves.

3) no "franchise store ID system"

30 The cited combination of references does not show or suggest a "franchise store ID

² See description in *Ross, Jr. et al.*, Col. 22, Lines 25-60.

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system", as recited in claim 1.

The rejection notes that *Ross, Jr. et al.* does not specifically show a franchise store ID system as set forth in claim 1.³ To show such a limitation, the rejection proposes modifying *Ross, Jr. et al.* in view of *McGee*.⁴

5 However, even if *Ross, Jr. et al.* could be modified according to the teachings of *McGee*, all the limitations of claim 1 would not be met. *McGee* provides no matching of a person to a franchise store based on url values. As recited in the Abstract of *McGee*, the reference teaches the return of a Web page in response to a request, not a person.

10 [A] session manager which intercepts all incoming *requests* from clients for Web pages. Each *request* incorporates a token... a URL associated with the matching token is used... to return a Web page indicated by the URL to the requester.⁵

Thus, *McGee* associates a URL with a request, not a client (e.g., person).

15 For this reason, the cited references do not show or suggest a franchise store ID system, as recited in claim 1.

B) Motivation For the Proposed Modification/Combination of References is Lacking

Even if the cited combination of reference could show all the limitations of claim 1, the
20 requisite motivation for a prima facie case of obviousness is believed to be lacking.

To show various limitations of Applicant's claim 1, the rejection proposes modifying the reference as follows:

25 Please note that Ross does not specifically disclose a franchise system. However, Ross does disclose affiliations. In that regard, it would have been obvious to extend Ross with franchise in order to add another description of affiliated by the use of the word franchise. Thereby, one of ordinary skill would have been motivated to extend Ross with franchise and thereby increase the potential

³ See the Office Action, dated 11/01/04, Page 3, last two lines.

⁴ See the Office Action, dated 11/01/04, Page 5, first line to Page 6, first partial paragraph.

⁵ *McGee*, Abstract.

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additional parties who affiliate with the franchise.⁶

This motivation is not sufficient for a prima facie case of obviousness. The standard for suggestion/motivation in a prima facie case of obviousness is well settled:

5

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so *found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art.*

10

The above rationale is not from the references. While an Examiner may take official notice of those facts that are well known or common knowledge in the art, no such notice has been taken with respect to the above facts. If the Examiner is taking official notice regarding the above noted teachings, Applicant seasonably traverses such an assertion and requests a reference in support. Such a reference must address Applicant's claim limitations regarding a franchise arrangement, as claimed.

15

Along these same lines, the motivation for combining *Ross, Jr. et al.* in view of *McGee* is not sufficient for a prima facie case. The rationale for the modification is as follows:

20

Therefore, one of ordinary skill in the art would have been motivated to extend the system of Ross with a system for a franchise system store [the] system matches a franchise store to a person ordering via a member terminal when the person accesses the franchise system, the franchise store system matching franchise stores to the person accessing the franchise system based on uniform resource locator values set up in advance according to predetermined rules. (see the Office Action, dated 11/01/04, Page 6, Lines 4-9).

25

The above rationale appears to be only a conclusion, not a reason for combining the references. Further, as previously noted, such motivation/suggestion must come from the references themselves or generally available knowledge. Accordingly, the proposed motivation for

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⁶ See the Office Action, dated 11/01/04, Page 3, Lines 14-19.

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combining the references is not sufficient for a prima facie case of obviousness.

For all of these reasons, this ground for rejection is traversed.

C) Various Dependent Claims are Separately Patentable

5 Claim 2, which depends from claim 1 recites that the merchandise information memory data further includes "information for goods not available at one of the franchise stores, but available at the headquarter".

Such an arrangement is not believed to be shown in, or made obvious by, the cited combination of references.

10 The rejection argues that claim 2 is not patentable with the following rationale:

The [language of claim 2] is considered to be non-functional descriptive material. The phrases words in these claims are considered non-functional descriptive material. The phrase(s) and or word(s) are given little patentable weight because
15 the claim language limitation is considered non-functional descriptive material, which does not patentably distinguish the applicant's invention from Ross. Thereby, the non-functional descriptive material is directed only to the content of the data and does not affect either the structure or method/process of Ross, which leaves the method and system unchanged. (See the Office Action, dated
20 11/01/2004, Page 6, Lines 10-18).

The ground for rejection is defective and should be withdrawn.

Applicant respectfully requests clarification for the authority (e.g., MPEP section) upon which this ground for rejection is based. It is Applicant's understanding that the examination
25 guidelines regarding obviousness rejections is clear: all claim limitations must be shown or suggested, either explicitly or inherently. Further, in the case where it is argued that a limitation is inherently shown, the rejection should still cite those sections of the reference relied upon to show inherency. The limitations of claim 2 are believed to be clear and well supported by the Specification, and so must be considered.

30 The clear effects of the limitations of claim 2 are explicitly described in conjunction with the particular embodiment disclosed in the Specification. The above arrangement allows a

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franchise store to present items that are not available at the franchise store, but are available at a Headquarter, which can have huge number of goods as compared to a single franchise store:

5 Moreover, each Store can supply many kinds of goods information, not only for its own stock items but also for other goods based on the huge scale of data in Headquarter. (Applicant's original Specification, Page 5, first partial paragraph).

Ignoring a limitation the presents an explicitly defined advantageous feature of Applicant's invention is improper, and denies the Applicant a full and fair reading of the claimed invention.

10 It goes without saying that if the limitations of claim 2 are properly considered, the above rejection cannot have established a prima facie case of obviousness

For this reason, the rejection of claim 2 is traversed, and the claim is considered separately patentable over the cited reference.

15 Claim 4, which depends from claim 1, recites that the home page sending service sends predetermined guest home page data when a member server accessing the system does not match any franchise store.

To show the limitations of claim 4, the rejection argues the following:

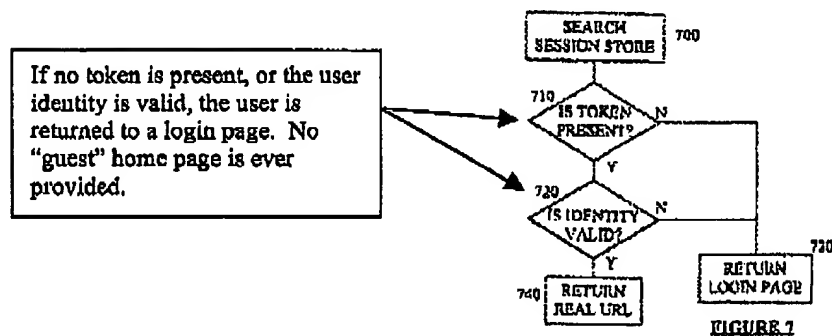
20 *McGee* teaches... the home page sending service sends predetermined guest home page data when a member server accessing the Franchise System does not match any franchise store (Col 13, lines 3-6 and Col 12, lines 32-47).⁷

25 Applicant respectfully disagrees, as the above-cited portions of *McGee* either clearly do not show the limitations of claim 4, or actually teach the opposite of claim 4.

With respect the reference teachings in column 12, there is no guest home page at all. The reference teaches repeatedly presenting a login page. If a user is never validated, the user never gets past a login page. This is clearly shown in FIG. 7 of *McGee* referenced by the text of column 12:

⁷ See the Office Action, dated 11/01/04, Page 7, Lines 1-3.

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The cited portion of claim 13 is no different. A full recitation of the portion is included in the excerpt below:

5 When, in response to a user request, the gateway processor 340 retrieves a page building gateway from the gateway store 380 (*step 425 of FIG. 4*)... Therefore... the gateway processor if necessary accesses the session store 330 to retrieve any prior-input dialogue information which is also to be included in the Web page. Then, in step 820, the HTML file for the Web page is generated, by well-known

10 procedures, on the basis of the respective information. Subsequently, the procedure continues with step 435 of FIG. 4. (*McGee*, Col. 12, Line 58 to Col. 13, Line 6, emphasis added).

From the above, it is clear that the teachings relied upon by the rejection occur in step 425.

15 However, step 425 cannot be reached if login data does is not matched:

The login procedure... occurs in step 425... Accordingly, it is assumed that the user... has provided a name, a password and has clicked on the submit button of the login page to initiate the login procedure... (*McGee*, Col. 10, Lines 44-50).

20

Thus, the above portion of *McGee* describes a page that is retrieved only after one accessing the system does match a database value (has logged in). This is essentially the opposite of Applicant's invention, which "sends predetermined guest home page data when a member server accessing the system does not match any franchise store.

25 For this reason, the reference does not show or suggest the limitations of claim 4, and this

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ground for rejection is traversed.

Claim 5, which depends from claim 1, recites that the url value includes a first portion unique to each franchise store and a second portion common to all franchise stores and the headquarters. To show the limitation, the rejection cites Col. 12, Lines 42-55 of *McGee*.⁸

Clarification of this ground for rejection is respectfully requested, as the cited portion of *McGee* never shows or suggests a url having first and second portions, as recited in claim 5. This portion of the reference only refers to a "real url", which is the url of a page reached after successful login (see FIGURE 7 of *McGee* above).

Thus because there is no mention of a different url portions in cited portion of the reference, let alone different portions referring to stores/headquarters, all the limitations of claim 5 have not been shown or suggested, and this ground for rejection is traversed.

II) Claims 10-12 are patentable over the cited references

The rejection of claims 10-12 will now be addressed.

A) The Combination of References Does Not Show All Claim Limitations

The cited combination of references does not show or suggest all the limitations of claim 10. In particular, the references do not show or suggest: (1) a plurality of franchise store servers, (2) a goods master database, (3) a home page creation system, or (4) a franchise store ID system.

1) No "plurality of franchise store servers"

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section I)A)1).

2) No "goods master database"

Applicant's claim 10 recites a goods master data base that stores information for goods sold by the plurality of franchise stores, such goods including goods... not available at the particular franchise store but available at a headquarter.

To address this ground for rejection, Applicant incorporates by reference the same

⁸ See the Office Action, dated 11/01/04, Page 7, Lines 5-7.

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general comments set forth above in Section I)C) directed to claim 2.

3) No "home page creation system"

To address this ground for rejection, Applicant incorporates by reference the same
5 general comments set forth above in Section I)A)2).

4) No "franchise store ID system"

To address this ground for rejection, Applicant incorporates by reference the same
general comments set forth above in Section I)A)3).

10

B) Motivation For the Proposed Modification/Combination of References is Lacking

To the extent that this ground for rejection relies on modifying *Ross, Jr. et al.* (both alone, and in view of *McGee*) the comments set forth above in Section I)B) are incorporated by reference herein.

15

C) Claim 11 is are Separately Patentable

Claim 11, which depends from claim 10, recites that the home page creation system "sends home page data corresponding to one the franchise stores if the member identification value and password correspond to the one franchise store, else sends guest home page data."

20

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section I)C) directed to claim 4.

D) Rejection of Claims 13 and 18 Improper

The rejection of claims 13 and 18 relies on the reference "Danneels".⁹ This reference
25 does not appear on the Notice of References cited and no identifying information regarding this reference (e.g., patent/publication number) is provided. Accordingly, the rejection of these claims is defective, and should be withdrawn.

⁹ See the Office Action, dated 11/1/04, Page 8, Lines 3-8.

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Rejection of Claims 6-9 Under 35 U.S.C. §103(a), based on *Ross, Jr. et al.* in view of *McGee*, further in view of *Conklin et al.* (U.S. Patent No. 6,332,135).

Claim 6, which depends from claim 1, recites that the at least one headquarter network server includes a member entry database that identifies previously accessing members and
5 matches said members to a predetermined franchise store according to said member entry data.

To the extent that this ground for rejection relies on the combination of *Ross, Jr. et al.* in view of *McGee*, the comments set forth above for claim 1 are incorporated by reference herein.

In addition, claim 6 is believed to be separately patentable over the cited reference.

To show the limitations of claim 6, the rejection relies on the reference *Conklin et al.*:

10 [R]egarding claim 6, ... the at least one headquarter network server further includes a member entry data base that identifies previously accessing members and matches said members to a predetermined franchise store according to said member entry data (see at least Abstract and Col. 19, Lines 62-63).¹⁰

15 The above-cited portion does not indicate any matching. In fact, the above-cited section of *Conklin et al.* teaches away from the limitations of claim 6 as it emphasizes buyers have to search for companies. This is essentially the opposite of being matched to a company as recited in claim 6.

20 Buyer processes... include *search* and evaluate processes 70, which *enable a prospective buyer to find companies* and their products in the community and investigate their prices, terms and service offerings... A buyer in this community can... determine an order's status in the system, etc. Note that access to relevant
25 information by each type of community member (sponsor, buyer, seller) is protected by password security and access levels. (*Conklin et al.*, Col. 19, Line 57 to Col. 20, Line 3, emphasis added).

30 From the above it is clear that *Conklin et al.* teaches buyers that search for companies, and thus the reference cannot show or suggest the matching limitations of claim 6.

¹⁰ See the Office Action, dated 11/01/04, Page 8, last paragraph.

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With respect to claims 7-9, as in the case of the rejection of claim 2, Applicant believes the rejection is defective by failing to give the claim limitations "patentable weight". Further, by ignoring Applicant's claim limitations the rejection cannot have established a prima facie case of obviousness.

The limitations of claims 7-9 are believed to be clear and well supported by the Specification, and so must be considered. Further, the clear effects of these limitations are explicitly described in conjunction with the particular embodiment disclosed in the Specification. In particular, Applicant's originally submitted Figs. 4-5 explicitly demonstrate how a member identification, password, franchise store code, and terminal ID code cause different effects in the functions of the system.

Ignoring the explicitly defined function determining limitations of Applicant's invention is improper, and denies the Applicant a full and fair reading of the claimed invention.

For this reason, the rejections of claims 7-9 are traversed, and these claims are considered separately patentable over the cited reference.

Rejection of Claim 14 Under 35 U.S.C. §103(a), based on *Ross, Jr. et al.* in view of *McGee*, further in view of *Spagna* (U.S. Patent No. 6,587,837).

Claim 14 depends from claim 10.

To the extent that this ground for rejection relies on the combination of *Ross, Jr. et al.* in view of *McGee*, Applicant incorporates by reference herein the comments set forth above for claim 10.

Rejection of Claims 15-18 Under 35 U.S.C. §103(a), based on *Ross, Jr. et al.* in view of *Conklin et al.*, further in view of *MICROSOFT* (Microsoft Dictionary, Third Edition)

D) Claims 15-18 are patentable over the cited references

The invention of claim 15 is directed to an electronic franchise shopping system for a plurality of franchise stores that includes a least one headquarter server and a plurality of franchise servers, each corresponding to a different franchise store.

The at least one headquarter server has a number of elements including a goods master

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data base, a member entry data base, a franchise store data base, a home page data base, a franchise store ID system, a home page sending system, and an order processing system.

A) The Combination of References Does Not Show All Claim Limitations

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The cited combination of references does not show or suggest all the limitations of claim

1. In particular, the references do not show or suggest: (1) a plurality of franchise store servers or (2) a franchise store ID system.

10 **1) No “plurality of franchise store servers”**

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section I(A)1).

15 **2) No “franchise store ID system”**

The franchise store ID system of claim 15 compares “an entered member identification value and member password to entries in the member entry data base, and if the member identification value and password match an entry in the member entry data base matching the accessing user to the corresponding franchise store, else matching the accessing user to a guest home page”.

20 To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above directed to the Rejection of Claims 1 and 10, Section I(C) directed to claim 4.

25 Rejection of Claim 19 Under 35 U.S.C. §103(a), based on *Ross, Jr. et al.* in view of *Conklin et al.*, further in view of *MICROSOFT*, even further in view of *Alsop* (U.S. Patent No. 5,970,472).

To the extent that this ground for rejection relies on the combination of *Ross, Jr. et al.* in view of *Conklin et al.*, the comments set forth above for claim 15 are incorporated by reference herein.

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Claim 11 has been amended, not in response to the cited art, but to address a typographical error.

For all of the above reasons, the present claims 1-19 are believed to be in allowable form. It is respectfully requested that the application be forwarded for allowance and issue.

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Respectfully Submitted,

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